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09/588,037	06/05/2000	J. Gregory Stout	A-68146/MAK/LM	8559

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/588,037	Applicant(s) Stout
Examiner Alexander Kalinowski	Art Unit 3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jun 5, 2000

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-8 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5, 6

6)  Other:

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## **DETAILED ACTION**

1. Claims 1-8 are presented for examination.

### *Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Applicant claims priority to Application Serial Number 08/853,955. However, the declaration fails to claim the benefit under 35 USC 120 of Application Serial Number 08/853,955. Therefore, for purposes of examination of the claims, the Examiner will apply the priority date of the 08/957,757 application to the instant application.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al.,

Pat. No. 5,642,485 (hereinafter Deaton) in view of Kepecs, Pat. No. 6,009,411.

As to claim 1, Deaton discloses a method for storing and retrieving consumer transaction information (see abstract), the method comprising:

capturing transaction information regarding a consumer at a first merchant (i.e. the system contains a database which contains relevant information about the frequency of the customer's transactions, the amount of the transaction ... )(col. 59, lines 54-60 and col. 61, line 49 - col. 62, line 52).

storing the captured selection information on a server (i.e. transaction processor 112)((see Fig. 1 and col. 11, lines 4-17).

Deaton does not explicitly disclose applying that captured transaction information to a transaction involving the consumer at a second merchant.

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However, Kepecs discloses applying that captured transaction information to a transaction involving the consumer at a second merchant (i.e. master stores 23 ... criterion fields can be matched by the past purchasing patterns of consumers ... match customer, criteria, and discount information ... database contains information on the particular retailers who stock each of the discounted items)(see Fig. 3, col. 8, lines 29-46 and line 64 - col. 9, line 5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include applying that captured transaction information to a transaction involving the consumer at a second merchant as disclosed by Kepecs within the Deaton method for the motivation of providing a customer discount choices of items available in a collection of stores over a network (col. 2, lines 40-48).

As to claim 2, Deaton does not explicitly disclose the method of claim 1, wherein before the step of applying, the following step is performed

identifying the consumer in a transaction at the second merchant.

However, Kepecs discloses identifying the consumer in a transaction at the second merchant (i.e. Customer\_No)(col. 10, lines 5-18). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include identifying the consumer in a transaction at the second merchant as disclosed by Kepecs within the Deaton method for the motivation of permitting the customer to track his or her total consumption history (col. 2, lines 11-19).

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As to claim 3, Deaton does not explicitly disclose the method of claim 1, wherein before the step of applying, the following step is performed

communicatively coupling the first and second merchants and the server by means of an internet.

However, Kepecs discloses communicatively coupling the first and second merchants and the server by means of an internet (Fig. 1 and Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include communicatively coupling the first and second merchants and the server by means of an internet as disclosed by Kepecs within the Deaton method for the motivation of permitting the customer to track his or her total consumption history (col. 2, lines 11-19).

As to claim 4, Deaton discloses the method of claim 1, wherein the step of capturing comprises capturing consumer information at the first merchant (i.e. the system contains a database which contains relevant information about the frequency of the customer's transactions, the amount of the transaction ... )(col. 59, lines 54-60 and col. 61, line 49 - col. 62, line 52).

As to claim 5, Deaton discloses the method of claim 1, wherein the step of capturing comprises capturing consumer loyalty information at the first merchant (i.e. frequency of customer's transactions)(col. 59, lines 54-60).

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As to claim 6, Deaton does not explicitly disclose the method of claim 1, wherein the step of storing comprises storing the captured selection information on a server external to the first merchant.

However, Kepecs discloses the step of storing comprises storing the captured selection information on a server external to the first merchant (i.e. DAP and DAP Internet Server)(Fig. 1 and Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the step of storing comprises storing the captured selection information on a server external to the first merchant as disclosed by Kepecs within the Deaton method for the motivation of permitting the customer to track his or her total consumption history (col. 2, lines 11-19).

As to claim 7, Deaton discloses the method of claim 1, wherein the step of storing comprises forwarding the captured selection information to the server (i.e. transaction processor 112)((see Fig. 1 and col. 11, lines 4-17)).

As to claim 8, Deaton does not explicitly disclose the method of claim 1, wherein the step of applying comprises

applying that captured transaction information to a transaction involving the consumer at a second merchant and initiated by a browser on a personal computer connected to the internet.

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However, Kepecs discloses applying that captured transaction information to a transaction involving the consumer at a second merchant and initiated by a browser on a personal computer connected to the internet (i.e. consumers use their computers 10 for connection to the computer 11 of the DAP through the internet (col. 4, lines 31-47 and col. 9, lines 31-44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include applying that captured transaction information to a transaction involving the consumer at a second merchant and initiated by a browser on a personal computer connected to the internet as disclosed by Kepecs within the Deaton method for the motivation of providing a customer discount choices of items available in a collection of stores over a network (col. 2, lines 40-48).

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pat. No. 6,101,482 discloses a system for purchasing products and services on-line.
- b. Pat. No. 6,424,949 discloses a system and method for selective incentives at a point of sale based on a customer's prior purchase history.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 6:30 AM to 4:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Patent Examiner

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September 8, 2002